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EXAMINER
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CHEN, CHONGSHAN

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,183

Applicant(s)

CAPPS, STEPHAN P.

Examiner

Chongshan Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. This action is responsive to communications filed on July 22, 2005. Claims 1, 2, and 4-50 are pending in this Office Action.

#### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1, 2, 4-23 and 37-50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
4. Claims 1, 2 and 4-23 claim a system, but do not explicitly disclose the system is embodied in a hardware. Without hardware, the claim is at best directed to an arrangement of software, *per se*, and they are rejected under §101 as not being tangible.
5. Claims 37-50 are not limited to tangible embodiments. In view of Applicant's disclosure, specification page 11, [0035], the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., computer storage media) and intangible embodiments (e.g., carrier wave). As such, the claim is not limited to statutory subject matter and is therefore non-statutory. To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4-6, 9, 11, 20, 24, 25, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (Pub. No.: US 2002/0087521 A1) in view of Thorner et al. ("Thorner", US 6,463,443).

As per claim 1, Lee teaches a system for automatically alerting a user to available information comprising:

parsing an electronic document, said electronic documents including any of a word processor document, an Internet Web page, a spreadsheet, and any textual and graphical data rendered on a display device, to identify data representing any person (Lee, page 1, [0005]-[0020], page 2, [0032]-[0033]);

identify at least one person represented by the identified data (Lee, page 1, [0005]-[0020], page 2, [0032]-[0033]).

Lee does not explicitly disclose retrieving information relating to each identified person from at least one electronic database; notifying the user that the retrieved information is available; and using at least a portion of the retrieved information relating to one or more of the identified persons to provide at least one electronic interface for initiating communication with those identified persons.

Thorner teaches retrieving information relating to each identified person from at least one electronic database; notifying the user that the retrieved information is available (Thorner, col. 4, lines 40-61, "A person A at the computer 1 states that he/she intends to make a database search for a person and/or family, and/or organization related information, below called subject information ..."); and

using at least a portion of the retrieved information relating to one or more of the identified persons to provide at least one electronic interface for initiating communication with those identified persons (Thorner, col. 4, lines 62-67, "Automatic connection to a inquired person/family/company", col. 7, lines 43-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lee by incorporating the means of searching and communicating with the identified person as disclosed by Thorner (Thorner, col. 4, lines 40-67, col. 7, lines 43-55). One of ordinary skill in the art would have been motivated to do this because Lee suggests to further processing the name to check its validity. One good way to validate the name is contact the person directly to verify the name using the communication means as disclosed by Thorner. This ensures the validity of the name.

As per claim 4, Lee and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach wherein the at least one electronic interface for initiating communication with one or more of the identified persons includes any of an email address, an instant message, a telephone number, a fax number, and an Internet address for communicating with the identified person (Thorner, col. 7, lines 42-55).

As per claim 5, Lee and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach wherein parsing an electronic document to identify data representing any person comprises identifying textual data associated with any person (Lee, page 1, [0005]-[0020], page 2, [0032]-[0033]).

As per claim 6, Lee and Thorner teach all the claimed subject matters as discussed in claim 5, and further teach wherein the textual data associated with any person includes any of: a name, an email address, a telephone number, a fax number, and a social security number (Lee, page 1, [0005]-[0020], page 2, [0032]-[0033]).

As per claim 9, Lee and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach wherein identifying at least one person represented by the identified data comprises comparing the identified data to information in at least one electronic database to identify each person associated with the identified data (Thorner, col. 4, lines 40-67).

As per claim 11, Lee and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach wherein notifying the user that the retrieved information is available comprises automatically providing a visible alert when the information is retrieved from the at least one electronic database (Thorner, col. 8, lines 15-20).

As per claim 20, Lee and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach a graphical user interface for interacting with the retrieved information (Thorner, col. 4, lines 62-67).

As per claim 24, Lee teaches a computer-implemented process for automatically providing information on a computer display device, comprising:

scanning electronic data being rendered on the computer display device to identify information within the electronic data that represents at least one person (Lee, page 1, [0005]-[0020], page 2, [0032]-[0033]);

identifying each person represented by the identified information (Lee, page 1, [0005]-[0020], page 2, [0032]-[0033]).

Lee does not explicitly disclose retrieving information relating to each identified person from at least one electronic database; providing an alert for indicating that the retrieved information is available; using at least a portion of the retrieved information relating to one or more of the identified persons to provide a user interface for initiating communication with those identified persons via at least one electronic communication access point.

Thorner teaches retrieving information relating to each identified person from at least one electronic database; providing an alert for indicating that the retrieved information is available (Thorner, col. 4, lines 40-61, "A person A at the computer 1 states that he/she intends to make a database search for a person and/or family, and/or organization related information, below called subject information ..."); and

using at least a portion of the retrieved information relating to one or more of the identified persons to provide a user interface for initiating communication with those identified persons via at least one electronic communication access point (Thorner, col. 4, lines 62-67, "Automatic connection to a inquired person/family/company", col. 7, lines 43-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lee by incorporating the means of searching and communicating with the identified person as disclosed by Thorner (Thorner, col. 4, lines 40-67,

col. 7, lines 43-55). One of ordinary skill in the art would have been motivated to do this because Lee suggests to further processing the name to check its validity. One good way to validate the name is contact the person directly to verify the name using the communication means as disclosed by Thorner. This ensures the validity of the name.

As per claim 25, Lee and Thorner teach all the claimed subject matters as discussed in claim 24, and further teach the user interface provides a user access for viewing the retrieved information (Thorner, col. 4, lines 18-67).

Claims 35 and 36 are rejected on grounds corresponding to the reasons given above for claims 1, 4-6, 9, 11 and 20.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (Pub. No.: US 2002/0087521 A1) in view of Thorner et al. ("Thorner", US 6,463,443) and further in view of Srinivasan (US 6,717,936).

As per claim 2, Lee and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach providing electronic interface (email) for initiating communication with the person. However, neither Lee nor Thorner explicitly discloses the at least one electronic interface for initiating communication is displayed to a user as an icon representing at least one communication access point related to the retrieved information. Srinivasan teaches the at least one electronic interface for initiating communication is displayed to a user as an icon representing at least one communication access point related to the retrieved information (Srinivasan, col. 6, lines 62-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lee and Thorner's combined system by incorporating the icon as disclosed by Srinivasan (Srinivasan, col. 6, lines 62-64). The



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motivation being to display the communication program in a conventional practice such as an icon on the display for the user to initiate communication with a person.

9. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (Pub. No.: US 2002/0087521 A1) in view of Thorner et al. ("Thorner", US 6,463,443) and further in view of Dimitrova (US 6,363,380).

As per claim 7, Lee and Thorner teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing parsing an electronic document to identify data representing any person comprises identifying graphical data associated with any person. Dimitrova teaches parsing graphical data to identify person (Dimitrova, col. 12, lines 1-7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lee and Thorner's combined system by incorporating a graphical parser as disclosed by Dimitrova (Dimitrova, col. 12, lines 1-7). The motivation being to enable the system to identify not only textual data but also graphical data associated with a person.

As per claim 8, Lee, Thorner and Dimitrova teach all the claimed subject matters as discussed in claim 7, and further teach the graphical data associated with any person includes any image for representing at least one person (Dimitrova, col. 12, lines 1-7).

10. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (Pub. No.: US 2002/0087521 A1) in view of Thorner et al. ("Thorner", US 6,463,443) and further in view of Sorensen (US 6,628,729).

As per claim 10, Lee and Thorner teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing wherein notifying the user that the retrieved information is available comprises automatically providing an audible alert when the information is retrieved

from the at least one electronic database. Sorensen teaches providing an audible alert when information is retrieved (Sorensen, col. 3, lines 27-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lee and Thorner's combined system by incorporating an audio alert as disclosed by Sorensen (Sorensen, col. 3, lines 27-30). The motivation being to promptly reminder the user that information is available.

Claim 12 is rejected on grounds corresponding to the reasons given above for claims 10 and 11.

11. Claims 13-15, 26-30, 37, 38, 40-45 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (Pub. No.: US 2002/0087521 A1) in view of Thorner et al. ("Thorner", US 6,463,443) and further in view of Yamakita (US 6,272,490).

As per claim 13, Lee and Thorner teach all the claimed subject matters as discussed in claim 11, except for explicitly disclosing the visible alert comprises dynamically modifying the appearance of the electronic document. Yamakita teaches the visible alert comprises dynamically modifying the appearance of the electronic document (Yamakita, abstract, "word is highlighted"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lee and Thorner's combined system by modifying the appearance of the electronic document as disclosed by Yamakita. The motivation being to notify the user the information is available.

As per claim 14, Lee, Thorner and Yamakita teach all the claimed subject matters as discussed in claim 13, and further teach changing the appearance of the identified data (Yamakita, abstract, "word is highlighted").

As per claim 15, Lee, Thorner and Yamakita teach all the claimed subject matters as discussed in claim 14, and further teach automatically associating at least one hyperlink with the identified data (Yamakita, col. 1, lines 35-67).

Claims 26-30, 37, 38, 40-45 and 50 are rejected on grounds corresponding to the reasons given above for claims 1, 4-6, 9, 11, 13-15, 20, 24, 25, 35 and 36.

12. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (Pub. No.: US 2002/0087521 A1) in view of Thorner et al. ("Thorner", US 6,463,443) in view of Yamakita (US 6,272,490) and further in view of Dimitrova (US 6,363,380).

As per claim 39, Lee, Thorner and Yamakita teach all the claimed subject matters as discussed in claim 38, except for explicitly disclosing identifying characteristics of at least one image within the electronic document using at least one image recognition technique. Dimitrova teaches identifying characteristics of at least one image within the electronic document using at least one image recognition technique (Dimitrova, col. 12, lines 1-7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lee, Thorner and Yamakita's combined system by incorporating a graphical parser as disclosed by Dimitrova (Dimitrova, col. 12, lines 1-7). The motivation being to enable the system to identify not only textual data but also graphical data associated with a person.

13. Claims 16-19, 21-23 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (Pub. No.: US 2002/0087521 A1) in view of Thorner et al. ("Thorner", US 6,463,443) and further in view of Appelman et al. ("Appelman", US 6,539,421).

As per claim 16, Lee and Thorner teach all the claimed subject matters as discussed in claim 11, except for explicitly disclosing the visible alert comprises dynamically adding at least

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one presence indicator to the electronic document. However, Lee and Thorner teach using electronic communication (email) to communicate with a person. Appelman teaches using instant messaging, which is a type of electronic communication system, to communicate with a person (Appelman, col. 4, lines 24-30). Instant messaging system provides a visible alert that adds presence indicator associated with the person (Appelman, col. 5, lines 52-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lee and Thorner's combined system by using a instant messaging system with presence indicator as disclosed by Appelman to communicate with the identified person. The motivation being to provide a faster and efficient way to communicate with the identified person because with email system, the message sender will never know when the person will read the email and reply to the email message. Instant message system tells the user whether the person is online or not, and allows the user to communicate with the person right away in real time.

As per claim 17, Lee, Thorner, and Appelman teach all the claimed subject matters as discussed in claim 16, and further teach the instant message system provides online status (Appelman, col. 4, lines 24-30, col. 5, lines 52-55), which automatically determining an online status for each identified person by querying at least one messaging account server for each identified person.

As per claim 18, Lee, Thorner and Appelman teach all the claimed subject matters as discussed in claim 17, and further teach each presence indicator graphically represents the online status of each identified person (Appelman, col. 5, lines 52-55).

As per claim 19, Lee, Thorner and Appelman teach all the claimed subject matters as discussed in claim 18, and further teach using instant messaging system to communicate with the

person and display the online status of the person (Appelman, col. 4, lines 24-30, col. 5, lines 52-55), which includes the graphical representation of the online status of each identified person is automatically updated by re-querying the at least one messaging account server for each identified person.

As per claim 21, Lee and Thorner teach all the claimed subject matters as discussed in claim 20, except for explicitly disclosing the graphical user interface comprises at least one pop-up window for displaying the retrieved information for each identified person. Appelman teaches the graphical user interface comprises at least one pop-up window for displaying the retrieved information for each identified person (Appelman, Fig. 28-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lee and Thorner's combined system by incorporating the use of pop-up window as disclosed by Appelman (Appelman, Fig. 28-29). The motivation being to attract the user attention by using a pop-up window.

As per claim 22, Lee, Thorner and Appelman teach all the claimed subject matters as discussed in claim 20, and further teach the graphical user interface comprises at least one context-sensitive menu for interacting with the retrieved information for each identified person (Appelman, Fig. 28-29).

As per claim 23, Lee, Thorner and Appelman teach all the claimed subject matters as discussed in claim 20, and further teach the graphical user interface comprises at least one hyperlink for accessing the retrieved information for each identified person via a computer pointing device (Appelman, Fig. 5).

Claims 31-34 are rejected on grounds corresponding to the reasons given above for claims 16-19 and 21-23.

14. Claims 46-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (Pub. No.: US 2002/0087521 A1) in view of Thorner et al. ("Thorner", US 6,463,443) in view of Yamakita (US 6,272,490) and further in view of Appelman et al. ("Appelman", US 6,539,421).

Claims 46-49 are rejected on grounds corresponding to the reasons given above for claims 16-19, 21-23 and 37.

#### *Response to Arguments*

15. Applicant's arguments with respect to claims 1, 2, and 4-50 have been considered but are moot in view of the new ground(s) of rejection.

#### *Contact Information*


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chongshan Chen whose telephone number is (571) 272-4031. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chongshan Chen  
August 4, 2005

  
**JEAN M. CORRIELUS**  
**PRIMARY EXAMINER**